IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Karl PETERSON et al.

Application No.: 10/697,656 Group Art Unit: 1769

Confirmation No.: 8487

Filed: October 31, 2003 Examiner: Ram N Kackar

For: ION GAUGE CONDITION DETECTOR AND SWITCHING CIRCUIT

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed October 3, 2005, having a shortened period for response set to expire on November 3, 2005, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect Group II, apparatus claims 1-10. Within Group II, applicants provisionally elect Invention A, apparatus claims 1-3 and 8-10.

II. Applicants Traverse the Requirement

As discussed with the Examiner, it is believed that the division of Group II into Invention A and Invention B is inappropriate. First, the Examiner refers to "Invention" A and "Invention" B. However, all claims listed by the Examiner relate to the same base claim (independent claim 1). Accordingly, it is not understood how the Examiner could believe the claims relate to separate inventions.

Second, as a basis for the division into Invention A and Invention B, the Examiner cites MPEP § 806.04(b). The Examiner asserts that distinctness is proven for the claims if the intermediate product is useful to make [sic.] other than the final product." However, claims 1-3 and 8-10 and claims 4-7 are not directed to an intermediate product and a final product. MPEP

§ 806.04(b) would apply if, for example, a portion of the claims were directed to a semiconductor device having only two layers and another portion of the claims were directed to a semiconductor device having those two layers and additional layers. This is very different from what is claimed by claims 1-10. Further, the MPEP § 806.04 indicates that distinctness is proven if the intermediate product has a separate use. Claims 4-7 depend on claim 1. As written, claims 4-7 can only be used in a device to implant impurities into a semiconductor wafer. Even if claims 4-7 were directed to an intermediate product, there is no separate use.

Third, the Examiner indicates that Invention A (claims 1-3 and 8-10) is directed to an ion gauge controller. However, the Examiner failed to recognize that claims 4-7 are directed to relay circuits and delay circuits, which maybe part of the ion gauge controller. Therefore, the Examiner's own characterization of the differences between the claims is incorrect.

There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing claims much more different than these of groups A and B. Also, the Examiner has not identified different classifications. It is believed that evaluation of both set of claims would not provide an undue burden upon the Examiner, especially in view of computer searching. On the other hand, there would be a great burden upon the Applicants, with additional expense and delay, if they had to protect the subject matter of Group B by filing a divisional application.

III. Conclusion

Upon review of references involved in this field of technology, when considering the subject matter of the claim groups, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims 1-10 should be examined in the subject application.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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Date: Nov 4, 2003

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